



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Frank J. Hughes, et al. Examiner: Philip C. Tucker
Serial No. 09/746,322 Group Art Unit: 1712
Filed: December 21, 2000 Docket No. 589.011US1
Title: NOVEL NAPTHOPYRAN COMPOUNDS, PHOTSENSITIVE
COMPOSITIONS AND LENSES


MAIL STOP ISSUE FEE

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

- ☒ Form PTOL-85B (1pg), plus one copy
- ☒ Communication Re: Issue Fee Transmittal, with Authorization for Fees
- ☒ Copy of Notice of Allowance and Issue Fee Due, Notice of Allowability, Examiner's Amendment, Examiner-Initiated Interview Summary, and Determination of Patent Term Adjustment
- ☒ Transmittal Sheet
- ☒ Return postcard

Please consider this a PETITION FOR EXTENSION OF TIME for sufficient number of months to enter these papers if an additional extension of time is deemed necessary by the Office. Authorization is hereby given to charge Deposit Account Number 50-1391 if such additional extension is necessary.

MARK A. LITMAN & ASSOCIATES, P.A.
York Business Center, Suite 205, 3209 W. 76th St.
Edina, MN 55435 (952-832-9090)

By: 
Atty: Mark A. Litman
Reg. No. 26,390

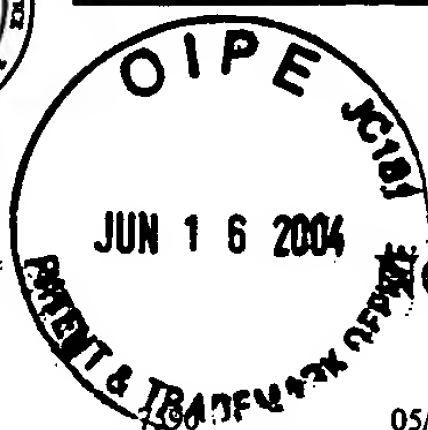
CERTIFICATE UNDER 37 C.F.R. 1.8: The undersigned hereby certifies that this Transmittal Letter and the paper, as described herein, are being deposited in the United States Postal Service, as first class mail, with sufficient postage, in an envelope addressed to: Mail Stop Issue Fee, Commissioner for Patents, PO Box 1450, Alexandria, VA 22313-1450 on June 11, 2004.

Mark A. Litman
Name


Signature



UNITED STATES PATENT AND TRADEMARK OFFICE



05/06/2004

Mark A. Litman & Associates, P.A.
York Business Center, Suite 205
3209 West 76th St.
Edina, MN 55435

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
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EXAMINER

TUCKER, PHILIP C

ART UNIT

PAPER NUMBER

1712

DATE MAILED: 05/06/2004

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/746,322	12/21/2000	Frank J. Hughes	589.011US1	9537

TITLE OF INVENTION: NOVEL NAPHTHOPYRAN COMPOUNDS, PHOTORESPONSIVE COMPOSITIONS AND LENSES

APPLN. TYPE	SMALL ENTITY	ISSUE FEE	PUBLICATION FEE	TOTAL FEE(S) DUE	DATE DUE
nonprovisional	NO	\$1330	\$300	\$1630	08/06/2004

THE APPLICATION IDENTIFIED ABOVE HAS BEEN EXAMINED AND IS ALLOWED FOR ISSUANCE AS A PATENT. **PROSECUTION ON THE MERITS IS CLOSED.** THIS NOTICE OF ALLOWANCE IS NOT A GRANT OF PATENT RIGHTS. THIS APPLICATION IS SUBJECT TO WITHDRAWAL FROM ISSUE AT THE INITIATIVE OF THE OFFICE OR UPON PETITION BY THE APPLICANT. SEE 37 CFR 1.313 AND MPEP 1308.

THE ISSUE FEE AND PUBLICATION FEE (IF REQUIRED) MUST BE PAID WITHIN THREE MONTHS FROM THE MAILING DATE OF THIS NOTICE OR THIS APPLICATION SHALL BE REGARDED AS ABANDONED. THIS STATUTORY PERIOD CANNOT BE EXTENDED. SEE 35 U.S.C. 151. THE ISSUE FEE DUE INDICATED ABOVE REFLECTS A CREDIT FOR ANY PREVIOUSLY PAID ISSUE FEE APPLIED IN THIS APPLICATION. THE PTOL-85B (OR AN EQUIVALENT) MUST BE RETURNED WITHIN THIS PERIOD EVEN IF NO FEE IS DUE OR THE APPLICATION WILL BE REGARDED AS ABANDONED.

HOW TO REPLY TO THIS NOTICE:

I. Review the SMALL ENTITY status shown above.

If the SMALL ENTITY is shown as YES, verify your current SMALL ENTITY status:

A. If the status is the same, pay the TOTAL FEE(S) DUE shown above.

B. If the status is changed, pay the PUBLICATION FEE (if required) and twice the amount of the ISSUE FEE shown above and notify the United States Patent and Trademark Office of the change in status, or

If the SMALL ENTITY is shown as NO:

A. Pay TOTAL FEE(S) DUE shown above, or

B. If applicant claimed SMALL ENTITY status before, or is now claiming SMALL ENTITY status, check the box below and enclose the PUBLICATION FEE and 1/2 the ISSUE FEE shown above.

☐ Applicant claims SMALL ENTITY status.
See 37 CFR 1.27.

II. PART B - FEE(S) TRANSMITTAL should be completed and returned to the United States Patent and Trademark Office (USPTO) with your ISSUE FEE and PUBLICATION FEE (if required). Even if the fee(s) have already been paid, Part B - Fee(s) Transmittal should be completed and returned. If you are charging the fee(s) to your deposit account, section "4b" of Part B - Fee(s) Transmittal should be completed and an extra copy of the form should be submitted.

III. All communications regarding this application must give the application number. Please direct all communications prior to issuance to Mail Stop ISSUE FEE unless advised to the contrary.

IMPORTANT REMINDER: Utility patents issuing on applications filed on or after Dec. 12, 1980 may require payment of maintenance fees. It is patentee's responsibility to ensure timely payment of maintenance fees when due.

received
5-10-04 AM



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/746,322	12/21/2003	Frank J. Hughes	589.011US1	9537
7590 05/06/2004				
Mark A. Litman & Associates, P.A. York Business Center, Suite 205 3209 West 76th St. Edina, MN 55435				
		EXAMINER TUCKER, PHILIP C		
		ART UNIT 1712		
		PAPER NUMBER		

DATE MAILED: 05/06/2004

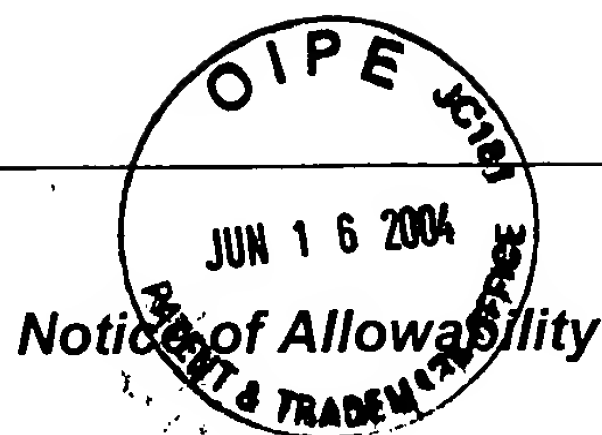
Determination of Patent Term Adjustment under 35 U.S.C. 154 (b) (application filed on or after May 29, 2000)

The Patent Term Adjustment to date is 296 day(s). If the issue fee is paid on the date that is three months after the mailing date of this notice and the patent issues on the Tuesday before the date that is 28 weeks (six and a half months) after the mailing date of this notice, the Patent Term Adjustment will be 296 day(s).

If a Continued Prosecution Application (CPA) was filed in the above-identified application, the filing date that determines Patent Term Adjustment is the filing date of the most recent CPA.

Applicant will be able to obtain more detailed information by accessing the Patent Application Information Retrieval (PAIR) system (<http://pair.uspto.gov>).

Any questions regarding the Patent Term Extension or Adjustment determination should be directed to the Office of Patent Legal Administration at (703) 305-1383. Questions relating to issue and publication fee payments should be directed to the Customer Service Center of the Office of Patent Publication at (703) 305-8283.



Application No.

09/746,322

Examiner

Philip C Tucker

Applicant(s)

HUGHES ET AL

Art Unit

1712

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to amendment of 12/11/03.
2. ☒ The allowed claim(s) is/are 25,30 and 32.
3. ☒ The drawings filed on 12/21/00 are accepted by the Examiner.
4. ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) ☐ All b) ☐ Some* c) ☐ None of the:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

* Certified copies not received: _____.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.

THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.

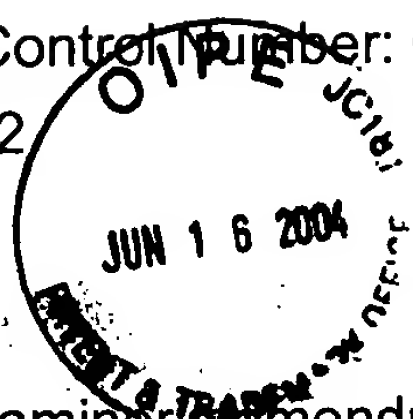
5. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
 6. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
 - (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
 - 1) ☐ hereto or 2) ☐ to Paper No./Mail Date _____.
 - (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date _____.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
7. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

- | | |
|---|---|
| 1. <input type="checkbox"/> Notice of References Cited (PTO-892) | 5. <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 2. <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 6. <input checked="" type="checkbox"/> Interview Summary (PTO-413),
Paper No./Mail Date _____. |
| 3. <input type="checkbox"/> Information Disclosure Statements (PTO-1449 or PTO/SB/08),
Paper No./Mail Date _____ | 7. <input checked="" type="checkbox"/> Examiner's Amendment/Comment |
| 4. <input type="checkbox"/> Examiner's Comment Regarding Requirement for Deposit
of Biological Material | 8. <input checked="" type="checkbox"/> Examiner's Statement of Reasons for Allowance |
| | 9. <input type="checkbox"/> Other _____. |

Philip C Tucker
Primary Examiner
Art Unit: 1712

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EXAMINER'S AMENDMENT

1. An examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it MUST be submitted no later than the payment of the issue fee.

Authorization for this examiner's amendment was given in a telephone interview with Mark Litman on 5/3/04.

The application has been amended as follows:

In the claims the status identifiers are corrected as follows:

1-24. (CANCELLED)

25. (PREVIOUSLY PRESENTED) A naphthopyran comprising 2,2-(4-methoxy-4'-pyrrolidino)diphenyl-5-methylol-7-fluoro-9-methoxy-[2H]-naphtho[1,2-b]pyran.

26. (CANCELLED)

27. (CANCELLED)

28. (CANCELLED)

29. (CANCELLED)

30. (CURRENTLY AMENDED) A photochromic composition containing at least one photochromic naphthopyran compound according to Claim 25 ~~26~~ and a polymeric

host material selected from the group consisting of polycarbonates and polyvinyl alcohol.

31. (CANCELLED)

32. (CURRENTLY AMENDED) A photochromic article having a layer thereon comprising the photochromic composition ~~article~~ according to Claim 30 characterized that the article is an ophthalmic lens.

In the specification,

On page 5, line 11, delete "reing" and insert therefor --ring--.

On page 7, line 5, delete "figure" and insert therefor --Formula--.

On page 10, line 16, after 1998 insert --now patent no. 6,478,988--.

On page 12, line 3 delete "sing" and insert therefor --ring--.

On page 22, line 19, delete "Figures" and insert therefor --Formulae--.

On page 23, line 7, delete "figures" and insert therefor --formulae--.

On page 23, lines 9-15 replace the paragraph as follows:

--Example 3

Two other dyes, the structures of all are shown as ~~No. I and No. II~~ Structures 1 and 2 in the accompanying formulae were also provided by essentially the identical procedures described above, by selection of the appropriate naphthol and propargyl alcohol. Each dye displayed photochromic behavior with two maximum peaks between

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450 and 620 nm. It is a preferred characteristic of the dyes of the present invention to display two absorption maximum peaks, one between 440 and 510 nm, the other between 550 and 630 nm. –

2. The following is an examiner's statement of reasons for allowance: The prior art of record, such as WO '695 and Tanizawa, and in general fails to teach or suggest the current compound of claim 25, containing the F at the 7-position, and methoxy at the 9-position to one of ordinary skill in the art.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Philip C Tucker whose telephone number is 571-272-1095. The examiner can normally be reached on Monday - Friday, Flexible schedule.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on 571-272-1119. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Application/Control Number: 09/746,322

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Philip C Tucker
Primary Examiner
Art Unit 1712

PCT-3004

Examiner-Initiated Interview Summary		Application No.	Applicant(s)
		09/746,322	HUGHES ET AL.
		Examiner	Art Unit
		Philip C Tucker	1712
All Participants: (1) <u>Philip C Tucker.</u> (2) <u>Mark Litman.</u>		Status of Application: _____ (3) _____ (4) _____	
Date of Interview: <u>3 May 2004</u>		Time: _____	
Type of Interview: <input checked="" type="checkbox"/> Telephonic <input type="checkbox"/> Video Conference <input type="checkbox"/> Personal (Copy given to: <input type="checkbox"/> Applicant <input type="checkbox"/> Applicant's representative)			
Exhibit Shown or Demonstrated: <input type="checkbox"/> Yes <input type="checkbox"/> No If Yes, provide a brief description:			
Part I. Rejection(s) discussed: Claims discussed: Prior art documents discussed:			
Part II. SUBSTANCE OF INTERVIEW DESCRIBING THE GENERAL NATURE OF WHAT WAS DISCUSSED: <i>Agreed to amend the specification in order to correct minor errors as in the examiners amendment.</i>			
Part III. <input checked="" type="checkbox"/> It is not necessary for applicant to provide a separate record of the substance of the interview, since the interview directly resulted in the allowance of the application. The examiner will provide a written summary of the substance of the interview in the Notice of Allowability. <input type="checkbox"/> It is not necessary for applicant to provide a separate record of the substance of the interview, since the interview did not result in resolution of all issues. A brief summary by the examiner appears in Part II above.			
<hr/> (Examiner/SPE Signature)		<hr/> (Applicant/Applicant's Representative Signature – if appropriate)	